

Appl. No. 10/010,310
Atty. Docket No.: 112415.122/AUR-010US
Response to Office Action dated Dec. 8, 2004

REMARKS/ARGUMENTS

I. Interview Summary:

At the outset, Applicant's representative would like to thank the Examiner for the courtesy of participating in a telephonic interview. Pursuant to 37 C.F.R. § 1.133, Applicant submits the following Interview Summary.

On December 13, 2004, a telephonic interview was held with James T. Olesen, Ph.D., and Joseph J. Koipally, Ph.D., participating on behalf of the Applicant, and Examiner Gailene Gabel, Ph.D., participating from the United States Patent and Trademark Office, to discuss the Restriction Requirement mailed on December 8, 2004.

Prior to the Examiner Interview, Applicant's representatives faxed the Examiner a copy of draft claims for discussion, as well as a suggested regrouping of the pending claims that differed from the grouping of the Restriction Requirement of December 8, 2004 (*see*, Exhibit A).

At the telephonic Examiner's Interview, Applicant's representatives requested that the Examiner reconsider the Restriction Requirement and regroup the inventions into the three groups indicated in the facsimile letter forwarded to the Examiner with the draft claims (*see*, Exhibit A). In particular, Applicant's representative urged that the claims of Group I and Group II (*i.e.*, claims 10-20, 22-24, 26-36, and 38-40) should be rejoined, since they represent very similar methods of identifying interacting proteins and the peptides with which they interact. In addition, Applicant's representatives informed the Examiner that they would consider canceling all claims reciting SEQ ID NOs (*i.e.*, claims 21-22, 25, 37-38, 41, 53-54, 57, 70-71 and 74), but urged that claims related to P-glycoprotein 1 and P-glycoprotein 3 (*e.g.*, claims of Groups Ii and Iii, and claims of Groups Iii and Iiii) should be logically rejoined.

At the conclusion of the telephonic Examiner's Interview, the Examiner agreed with Applicant's representatives' arguments for rejoinder, and agreed that the claims of Groups Ii and Iii, as well as Groups Iiii and Iiii should be rejoined. The Examiner urged Applicants to timely submit their provisional election with traverse, and agreed to favorably rule on their arguments for rejoinder of these claims.

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II. Amendments to the Claims:

Claims 10-74 are pending in the instant application.

Claims 18, 21-22, 25, 28, 35, 37-38, 41, 51, 53-54, 57, 70-71, and 73-74 have been canceled herewith without prejudice or disclaimer of the subject matter contained therein. Applicants reserve the right to pursue the subject matter of these claims in this or a future related application. Applicants emphasize that these claims were canceled for reasons unrelated to patentability.

Claims 10, 12-17, 19, 26-27, 29, 34, 42, 45-50, 58, and 60-67 have been amended. These amendments are formalistic in nature. Support for these amendments can be found in the original claims, and throughout the application as filed.

Claims 75-78 have been newly added. Support for the new claims can be found throughout the application as filed, for example at page 10, lines 10-26; page 11, lines 1-3; page 33, line 1 to page 34, line 2; and Figures 2-3 of the application as filed.

No new matter has been added by way of the instant amendments and newly added claims.

Upon entry of the instant amendments to the claims, claims 10-17, 19-20, 23-24, 26-27, 29-34, 36, 39-40, 42-50, 52, 55-56, 58-69, 72, and 75-78 will be pending in the instant application.

III. Response to the Restriction Requirement:

In response to the Restriction Requirement, Applicant provisionally elects with traverse, Group Ii claims 10-20, 22, and 23, drawn to a method of identifying a polypeptide that binds to a peptide in human P-glycoprotein 1. As agreed to in their telephonic Examiner Interview on December 13, 2004, and as summarized in section I above, Applicant respectfully requests that the Examiner rejoin the claims of Groups Ii and Iii, with the claims of Groups III and IIii (*i.e.*, claims 10-17, 19-20, 23-24, 26-34, 36, and 39-40).

Applicant notes for the record that the standard for a proper Restriction Requirement is that the claimed inventions must be independent or distinct and searching and examining all of the claims together must impose a serious burden on the Examiner. M.P.E.P. § 803.

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Accordingly, Applicant respectfully avers that searching Groups Ii, Iii, Iii, and Iiii together would not constitute a significant burden. The search would not be unduly burdensome, because the claims of Groups Ii, Iii, Iii, and Iiii contain related subject matter. As discussed in their telephonic Examiner's Interview, and as summarized above in section I, Applicants hereby formally request official notice of rejoinder of the claims of Groups Ii and Iii, as well as Iii and Iiii, as agreed to previously.

IV. Response to the Species Election Requirement:

The Office Action of December 8, 2004 required a species election for claims 21, 25, 37, 41, 53, 57, 70, and 73 (*see*, page 7, section 2 of the Office Action).

Claims 21, 25, 37, 41, 53, 57, 70, and 73 have been canceled herewith. Accordingly, and as agreed to with the Examiner during the telephonic Examiner's Interview of December 13, 2004, this species election has been rendered moot.

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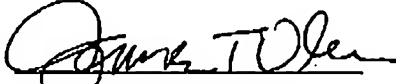
CONCLUSION

No fees are believed to be due in connection with this filing. However, please charge any underpayments, or credit any overpayments to our Deposit Account No. 08-0219. If there are any questions regarding this matter, the Examiner is invited to call the undersigned at the telephone number indicated below.

Respectfully submitted,

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Date: December 17, 2004


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